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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,885	04/24/2006	Mitsuo Kimura	JFE-06-1071	6151

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IP GROUP OF DLA PIPER US LLP
ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA, PA 19103

EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT	PAPER NUMBER
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1793

MAIL DATE	DELIVERY MODE
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04/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,885	Applicant(s) KIMURA ET AL.	
	Examiner CAITLIN FOGARTY	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25, 27-29, 31, 34-36 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 27-29, 31, 34-36, 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 25, 27 - 29, 31, 34 - 36, and 48 are pending and all have been amended. Claims 1 - 24, 26, 30, 32 - 33, and 37 - 47 have been cancelled.

Status of Previous Rejections

2. The following rejections have been withdrawn in view of the amendment filed on February 12, 2008:

- The 35 U.S.C. 112 second paragraph rejection of claims 25 - 32 and 34 - 36.
- Claims 25 - 29, 32 - 36, and 18 under 35 U.S.C. 102(b) as being anticipated by Kushida et al. (US 6,379,821 B2).
- Claims 30 - 31 and 34 - 36 as being unpatentable over Kushida et al. (US 6,379,821 B2).

3. The following rejection has been maintained:

- Claims 25 - 36 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 12 of copending Application No. 10/568,154.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 25, 27 - 29, 31, 34 - 36, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kushida et al. (US 6,379,821) in view of the *ASM Handbook*.

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With respect to instant claim 25, the abstract and col. 3 line 3 – col. 4 line 17 of Kushida et al. teach a highly corrosion resistant high strength stainless steel pipe for linepipe with a clearly overlapping composition as shown in the table below.

Element	Instant Claim 1 (mass %)	Kushida et al. (mass %)	Overlapping Range (mass %)
C	0.001 – 0.015	≤ 0.05	0.001 – 0.015
Si	0.01 – 0.5	0.01 – 1	0.01 – 0.5
Mn	0.1 – 1.8	0.05 – 2	0.1 – 1.8
P	≤ 0.03	≤ 0.025	≤ 0.025
S	≤ 0.005	≤ 0.01	≤ 0.005
Cr	15 – 18	9 – 20	15 – 18
Ni	0.5 – 5.5	0 – 9	0.5 – 5.5
Mo	0.5 – 3.5	0 – 5	0.5 – 3.5
V	0.02 – 0.2	0 – 0.5	0.02 – 0.2
N	0.001 – 0.015	≤ 0.02	0.001 – 0.015
O	≤ 0.006	≤ 0.01	≤ 0.006
Optional			
Al	0.002 – 0.05	0.001 – 0.1	0.002 – 0.05
Cu	≤ 3.5	0 – 5	0 – 3.5
Nb	≤ 0.2	0	0
Ti	≤ 0.3	≤ 0.1	0 – 0.1
Zr	≤ 0.2	0 – 0.5	0 – 0.2
B	≤ 0.01	0	0
W	≤ 3.0	0 – 6	0 – 3.0
Ca	≤ 0.01	0 – 0.05	0 – 0.01
Fe + impurities	Balance	Balance	Balance

Kushida et al. also teaches specific examples of stainless steel pipes that are within the compositional ranges recited in instant claim 25 in Table 5 examples a-c, e, and j-l.

Kushida et al. does not specifically teach equations (1) - (3), however since the compositional ranges of the stainless steel of Kushida et al. overlap with those recited in instant claim 25 the equations would be satisfied by the stainless steel of Kushida et al. Also, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art. *In re Cooper and Foley* 1943 C.D. 357,

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553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77 and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin et al.*, 149 USPQ 685, 688.

Kushida et al. differs from claim 25 because it does not teach that the high strength stainless steel pipe is a seamless pipe, but rather that it is a welded pipe. However, it would have been obvious to one of ordinary skill in the art that the stainless steel of Kushida et al. is capable of being formed into a seamless pipe or a welded pipe. It is well known in the art, as evidenced in Volume 1 of the 1990 10th Edition *ASM Handbook* p. 852 – 853, that the two most common types of pipes are welded and seamless pipes and the method of making either type is also well known.

Instant claims 27 – 29 and 31 further limit the compositions of Ni, Mo, and Cu. However, the stainless steel composition taught by Kushida et al. still overlaps with the ranges recited in instant claims 27 - 29 and 31.

Since the claimed compositional ranges of instant claims 25, 27 – 29, and 31 either overlap or are within the ranges disclosed by Kushida et al., a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed stainless steel pipe alloy composition from the stainless steel pipe alloy composition disclosed by Kushida et al. because Kushida et al. teaches the same utility (i.e. linepipe) in the whole disclosed range.

Regarding instant claims 34 – 36, the abstract and col. 3 line 3 to col. 4 line 17 of Kushida et al. teach that the microstructure of the stainless steel is desirably 55 – 90 volume% martensite phase and 10 – 45 volume% ferrite phase which overlaps with the ranges recited in instant claims 34 and 35. Furthermore, Table 6 examples 1 – 2, 5, and 10 – 12 of Kushida et al. disclose species with stainless steel compositions within the ranges of claim 25 that have microstructure within the ranges of claims 34 – 36. Kushida et al. does not specifically disclose that the stainless steel compositions contain residual austenite phase. However, claims 34 and 36 recite that the residual austenite phase is 40% or less or 30% or less by volume where both ranges include 0%. Therefore, since Kushida et al. does not teach the volume percent of austenite phase it is assumed to be 0% which is within the range recited in instant claims 34 and 36.

In regards to instant claim 48, the abstract and col. 3 line 3 to col. 4 line 17 of Kushida et al. disclose a stainless steel pipe with an overlapping composition with that recited in instant claim 25. Kushida et al. teaches that the stainless steel pipe may be used as a pipeline for conveying crude oil and natural gas. Kushida et al. does not specifically teach that the pipe is welded together to form the pipeline. However, it would have been obvious to one of ordinary skill in the art that in order to make a pipeline long enough to transport crude oil or natural gas, the stainless steel pipes would require welding to join together the individual pipes.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 25 – 36 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1 – 12 of

copending Application No. 10/568,154 as discussed in the November 15, 2007 Office action.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

8. Applicant's arguments with respect to claims 25 – 36 and 48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

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